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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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| 08/895,495 | 07/16/97 | SAITO M | 58800.919C |

| EXAMINER | |
|---|---|
| SAYADIAN, H | |
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22M2/0922

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**DATE MAILED:** 09/22/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on 7-16-1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days,~~ whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, ~~80, 83, 86, 89, and 92~~ is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) written above all is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☒ ~~The~~ specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

★ U.S. GPO: 1998-404-496/40517

# OBJECTIONS/REJECTIONS NOT BASED ON PRIOR ART

## *DISCLOSURE: Generally*

1. This disclosure--including disclosed specification, drawings, *and* claims--is replete with grammatical, style, punctuation, and typographical errors too numerous to mention *all* specifically.

Applicant must correct all errors in the application, *whether or not specifically mentioned in this office action.*

The corrections, of course, may not introduce new matter.

## *DISCLOSURE: Specification*

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or to use the invention, i.e., failing to provide an enabling disclosure. Because of the state of the detailed specification, it does not enable one of reasonable skill to make and practice the invention of claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92. Due the generally improper and idiomatic English used in this application, it is unclear wherein the detailed specification does Applicant discuss the invention of the claims so as to enable one of reasonable skill in the art to make and use it. Moreover, in very many places it is unclear whether Applicant discusses an invention presented in a prior Japanese application or describes the invention of this application.

3. A substitute specification in proper idiomatic English and in compliance with 37 C.F.R. 1.52(a) and (b) is required. A substitute specification is required because the detailed specification appears to be a literal translation into English from the foreign document and is replete with errors, making the detailed description ambiguous and generally unclear, correcting which errors would make the detailed description difficult to examine and difficult to print when the application is allowed. The errors are too numerous to specifically mention all--this Action lists some of the problems; the list, however, is not exhaustive. Applicant must review the detailed description and correct all errors and ambiguities, including ones not specifically mentioned below. ***Applicant is required to correct the detailed specification so as to meet the requirements of*** *35 U.S.C. 112.* Of course, new matter may not be introduced.

The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

***DISCLOSURE: Claims***

4. The ordering of the claims is objected to as containing intervening claims between claims and the claims that depend therefrom. This is not in accordance with 37 C.F.R. § 1.75 (g), which states: "(g) All dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.".

Before issue, claims of this patent application should be renumbered to conform with 37 C.F.R. § 1.75 (g).

5. Claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention.

As examples of the numerous mistakes, which render uncertain scope of the claims, Examiner notes that in claim 23, the recitation "copying said digital data a transfer utilization permit key ..." is incomprehensible (could Applicant be meaning to recite "copying said digital data *and* a transfer utilization permit key ..." ?); as well as "storing said digital data is said utilization permit key ..." (Could Applicant be meaning to recite "storing said digital data [is] *if* said utilization permit key ..." ?); in claims 53, 56, and 89 the recitation "the other part" lacks antecedent basis; and claims 71, 77, 80, 86, and 92 lack antecedent bases because they depend from claim 66, which now stands canceled.

## REJECTIONS BASED ON PRIOR ART

6. Examiner has read scope of the claims "recit[ing] ... [means, or steps, for] to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." See 35 U.S.C. § 112 ¶ 6; see, also, M.P.E.P. §§2181-2183 and cases cited therein.

Moreover, Examiner has read the scope of claims 23-94 as concomitant with the ambiguities necessitating the extensive rejections and objection in this application.

Furthermore, Examiner notes that the "controlling copyrights of digital data" recited in the preamble carries no weight because it is functional, intended use, or intended outcome recitations. Such recitations neither result in structural differences nor result in manipulative differences between the claimed invention and the prior art. The prior art cited below is capable of performing the functional, intended use, or intended outcome recitations and, therefore, meets these recitations.

7. Claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92 are rejected under 35 U.S.C. § 102(e) as being anticipated by any of Dolphin, Fahn et al. [hereinafter Fahn], Okano, Matsumoto et al. [hereinafter Matsumoto], or Gasser et al. [hereinafter Gasser].

The cited prior art, either expressly or inherently, teaches all of the limitations of the claims. Examiner notes that the claims recite, the possible alternative use of a display permit key, an edit permit key, a storage permit key, a copy permit key, and a transfer utilization permit key. Consequently, all that the prior art has to haveis one of said permit keys and the corresponding steps. The cited prior art, each, teaches a crypt key as well as at least one permit key and the corresponding steps that is the same or equivalent to the recited limitations in this application. Examiner notes that the cited prior art deals with data protected by encryption, which expressly and inherently requires a crypt key.

8. Moreover, Claims 25, 28, 35, 41, 44, 47, 50, 53, 56, 61, 64, 71, 77, 80, 83, 86, 89, and 92 are rejected under 35 U.S.C. § 103 as being unpatentable over any of Dolphin, Fahn, Okano, Matsumoto, or Gasser as applied to claims 23 and 59, and further in view of what is well known.

The deficiencies of the cited prior art, if any, with respect to the dependent claims 25, 28, 35, 41, 44, 47, 50, 53, 56, 61, 64, 71, 77, 80, 83, 86, 89, and 92 deal with features that are well known and commonly used in the art. Such features would, therefore, have been obvious to incorporate in the cited prior art.

For example, it is well known to attach digital signature to transmitted data to allow receivers to authenticate origin of received data and verify the absence of unauthorized changes in the data. It is also well known in the art to use copyright control messages and information along with copyrighted data to provide information about the use and control of the copyrights. It is also known in the art to use encrypted permit keys to prohibit the unauthorized access of protected data.

## REJECTIONS BASED ON DOUBLE PATENTING

9. Claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92 are directed to an invention not patentably distinct from claims 1-24 of commonly assigned U.S. Patent No. 5,646,999. Specifically, claims 1-24 in said Application anticipate the claims in this Application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, which is now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the alternate limitations recited in claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92.

10. Commonly assigned U.S. Pat. No. 5,646,999, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 C.F.R. 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

11. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

12. Claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims of said patent anticipate the claims in this application. In line with Applicant's admission, as stated in the third paragraph on p. 33 of Applicant's response to the First Action, US S.N. 08/549,271, now U.S. Pat. No. 5,646,999, teaches using two crypt keys to edit data; thus controlling copyrights of the data. Examiner notes that this anticipates the use of a crypt key along with a single alternate permit key and its corresponding step. For example, U.S. Pat. No. 5,646,999 the edit permit key and its corresponding steps, as one of the alternate limitations recited in claims 23, 25, 28, 35, 41, 44, 47, 50, 53, 56, 59, 61, 64, 71, 77, 80, 83, 86, 89, and 92.

13. Claims 25, 28, 35, 41, 44, 47, 50, 53, 56, and 61, 64, 71, 77, 80, 83, 86, 89, and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Pat. No. 5,646,999 and further in view of what is well known.

The deficiencies of said U.S. Application, if any, with respect to the dependent claims deal with features that are well known and commonly used in the art.

## THIS ACTION IS MADE FINAL

14. This is a continuation of Applicant's earlier Application No. 08/416,037. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

**A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION.**

In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action.

**IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.**

## PRIOR ART RELEVANT TO EXAMINING THE APPLICATION

15. The following prior art, which is made of record, is considered pertinent to the application. Linehan.

## INFORMATION ON HOW TO CONTACT THE USPTO

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hrayr A. Sayadian whose telephone number is (703) 306-4169. The examiner can normally be reached on Monday through Friday, from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Hrayr A. Sayadian
9-18-1997

THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
GROUP 2200